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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/186,064 11/04/98 TOOMBS

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EXAMINER

MYERS, P

ART UNIT

PAPER NUMBER

2181
DATE MAILED:

09/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/186,064

Applicant(s)

TOOMBS ET AL.

Examiner

Paul R. Myers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 November 1998 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 8/21/01 have been fully considered but they are not persuasive.

Applicants arguments that they are in compliance with 37 CFR 1.83(a) is not persuasive. The applicants have spent considerable effort in arguing that the well known feature of the card selecting the communication protocol that corresponds to the protocol of the master as opposed to the master telling the card which protocol to use is a patentable distinction over Iijima. While the examiner wholeheartedly disagrees with this argument. The mere fact that the applicants are arguing it as if it were a patentable distinction in the claim language means that this feature is essential subject matter and must be shown in the drawings. Since the examiner is unable to find this feature in the drawings and the applicants only argued that it is somewhere in drawings 1-8 without pointing out where, this requirement is maintained.

In response to applicants argument that support for the well known feature that the applicants argue make their invention patentably distinct from Iijima is found in "The MultiMediaCard System Specification" incorporated by reference. The attempt to incorporate essential subject matter into this application by reference to the feature of the card selecting the communication protocol that corresponds to the protocol of the master as opposed to the master telling the card which protocol to use is improper because according to applicants argument this is essential subject matter.

In response to applicants argument regarding the examiners taking of Official notice: The examiner notes the applicant failed to challenge the official notice thus the applicants

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agreement with the official notice is appreciated. The examiner is however citing the Users Manual for the SupraExpress 288 and the SupraExpress 288i PnP as support for this well known feature. Of the slave device the Modem selecting the communication protocol with the host without the host informing the slave device which protocol to use.

"Not only the specific teachings of a reference but also reasonable inferences which the artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection." In re Preda, 401 F.2d 825, 159 USPQ 342 (CCPA 1968) and In re Shepard 319 F.2d 194, 138 USPQ 148 (CCPA 1963).

"The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference." In re Bozek, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969).

"Every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein." In re Bode, 550 F.2d 656, 193 USPQ 12 (CCPA 1977).

"The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference." In re Bozek, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969).

The test of the obviousness is:

"whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention,". As shown in In re Gorman, 933 F. 2d at 986, 18 USPQ2d at 1888.

Subject matter is unpatentable under section 103 if it "'would have been obvious to a person having ordinary skill in the art.' While there must be some teaching, reason, suggestion,

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or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or prior art specifically suggest making the combination." As shown in *In re Nilssen*, 851 F. 2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988).

Such suggestion or motivation to combine prior art teachings can derive solely from the existence of a teaching, which one of ordinary skill in the art would be presumed to know, and the use of that teaching to solve the same [or] similar problem which it addresses." As shown in *In re wood*, 599 F. 2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979).

"In sum, it is off the mark for litigants to argue, as many do, that an invention cannot be held to have been obvious unless a suggestion to combine prior art teachings is found in a specific reference." As shown in *In re Oetiker*, 24 USPQ2d 1443 (CAFC 1992).

Accordingly, is not required to disclose or specifically suggest particular elements. Instead the measure is what the teachings of the reference would suggest to one of ordinary skill in the art, not what the reference specifically suggests.

Specification

2. The attempt to incorporate essential subject matter into this application by reference to the feature of the card selecting the communication protocol that corresponds to the protocol of the master as opposed to the master telling the card which protocol to use is improper because according to applicants argument this is essential subject matter.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the memory card selecting the protocol to use must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim Rejections - 35 USC § 103

2. Claims 1-68, 70-72 and 74-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iijima PN 5,349,649.

In regards to claims 1, 11, 23, 28, 39, 41, 51, 57, 66, 70, 74-76 and 85: Iijima teaches A memory card (1) for connecting to a master (7), comprising: a plurality of storage elements (2,3,40); and an interface (5) for communicating with the master (7), wherein data (data) and commands (command) are transferred between the card (1) and the master (7); wherein said card (1) is capable of adapting to the master running one protocol (Protocol A or Protocol B) from a plurality of protocols (A or B). Iijima teaches the memory card selecting the protocol based upon the masters informing it of which protocol to use. Iijima does not teach the memory card selecting the communication without the master informing it which protocol to use. Official notice is taken that it is very well known for a device to select the communication protocol based upon the communication protocol of another device to which it is to communicate. It would have been obvious for the memory card to select the protocol based upon the detected protocol of the master because this would have provided for backwards compatibility with older masters.

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In regards to claims 2-4, 14-16, 26-27, 30, 42-44, 52-53, 59-60, 67-68, 71-72, 78-79, 81 and 84: Iijima teaches handling plural protocols. Iijima does not teach which specific protocols are supported. Official notice is taken that the MultiMediaCard protocol and the Serial Peripheral Interface protocols are well known standard protocols. It would have been obvious to a person of ordinary skill in the art at the time of the invention to support these protocols because this would have made Iijima's card compliant to standards.

In regards to claims 5, 8, 9, 17, 20-21, 31, 32, 37, 45-46, 49, 54-56, 61, 63, 65, 80 and 83: Iijima teaches a common bus for transferring command and data. Iijima does not expressly teach the use of a select signal from the master. The serial peripheral interface (SPI) protocol is well known and described above. The SPI protocol includes select (CE), Data-in (SDI), Data-out (SDO) and Clock (SCLK) lines.

In regards to claims 6, 18, 33-34, 36, 47-48, 62, 64 and 82: Iijima teaches not needing a select signal. MultiMediaCard protocol does not require a select.

In regards to claims 7, 19 and 35: Iijima teaches the bus including command, data, and clock lines.

In regards to claims 10, 22, 38 and 50: Iijima teaches the card is a memory storage device.

In regards to claims 12, 24-25, 29, 40 and 58: Iijima teaches the reason for his invention is for connecting with masters that can only communicate in one protocol.

In regards to claim 13: Iijima teaches the adaptation of the card to the master being transparent to the master.

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3. Claims 69 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iijima PN 5,349,649 in view of Mote, Jr. PN 5,852,617.

In regards to claims 69 and 73: Iijima teaches one bus for communication. Iijima does not teach a distinct bus for each of the a plug-in card with two separate busses one for standard parallel communication and one for serial JTAG (error handling protocol) communication. With one protocol being serial and the other being parallel. It would have been obvious to a person of ordinary skill in the art at the time of the invention to use separate bussed one for the serial protocol and one for the parallel protocol because this would have for dual communication.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul R. Myers whose telephone number is 703 305-9656. The examiner can normally be reached on 6:30am to 4:00pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoleil can be reached on 703 305-9713. The fax phone numbers for the organization where this application or proceeding is assigned are 703 308-9051 for regular communications and 703 308-9052 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-3900.

PRM
September 18, 2001

A handwritten signature in black ink, appearing to read "Paul R. Myers". The signature is fluid and cursive, with a long horizontal stroke at the end.

PAUL R. MYERS
PRIMARY EXAMINER